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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,659	07/24/2003	William Patrick Tunney	11884/404501	8909
23838	7590	10/05/2006	EXAMINER	
KENYON & KENYON LLP 1500 K STREET N.W. SUITE 700 WASHINGTON, DC 20005			PATEL, SHEFALI D	
			ART UNIT	PAPER NUMBER
			2624	

DATE MAILED: 10/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/625,659	TUNNEY, WILLIAM PATRICK	
	Examiner	Art Unit	
	Shefali D. Patel	2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/13/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 6-7 and 16-17 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 9-10 and 17-18 of copending Application No.

10/625,597 in view of Wolff et al. (USPN 6,081,261).

Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claims recite “time” and the copending application recites “date”. The two are similar when it comes to its definition. Date is described as “the time or period to which any event or thing belongs” according to www.dictionary.com. Also, Wolff discloses time on the paper form and at the time of the invention, it would have been obvious to a person of ordinary skill in the art to use the teaching of Wolff for coordinates of time rather than date (note, Wolff discloses both time and date).

Therefore, they are obvious over the co-pending application.

Dependent claims 8-15 are rejected for the same reasons.

This is a provisional obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-8 and 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolff et al. (hereinafter, "Wolff") (US 6,081,261) in view of Ericson (US 6,666,376).

With regard to **claim 1** Wolff discloses a method comprising (Figures 1 and 5): receiving capture data from a capture device, the capture data representing positions of a set of marks made on paper overlaying a face (col. 5 lines 1-30) of the capture device (col. 3 lines 26-65, col. 7 lines 6-9 and col. 9 lines 44-46); comparing the capture data with one of a plurality of unique positions stored in memory in association with a plurality of clock times (note the clock time in Figure 1 and at col. 3 lines 48, 51 and 54-56) printed on the paper (col. 5 lines 22-26 and the calendar book information is disclosed at col. 3); retrieving from memory the clock time associated with the unique position that matches the capture data (col. 5 lines 48-55 and lines 1-6). Wolff does not expressly disclose storing the retrieved clock time in memory as the set of marks made on the paper. Ericson discloses this at col. 7 lines 25-38 and also on col. 5 lines 29-39. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the teaching of Ericson with Wolff. The motivation for doing so is to determine the unique clock time period, which identifies the first calendar area, thereby enabling the creation of an electronic back-up of the calendar as suggested by Ericson. Therefore, it would have been obvious to combine Ericson with Wolff to obtain the invention as specified in claim 1.

With regard to **claims 2 and 3** both Wolff and Ericson discloses the coordinates (x,y) and (x,y,t). Wolff at col. 7 lines 21-22, col. 8 lines 7-17, 26, 37 and 45. See, Ericson at col. 7 line 46.

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With regard to **claim 4** Wolff discloses capturing data simultaneously with the making of the set of marks on the paper (col. 2 lines 48-56, col. 4 lines 21-23).

With regard to **claim 5** Wolff discloses receiving a set of points from the capture device, the set of points representing orientation of the paper on the capture device; and determining the positions of the set of marks relative to the set of points (col. 8 lines 40-63).

Claim 6 is rejected the same as claim 1. Thus, arguments similar to that presented above for claim 1 is equally applicable to claim 6. Claim 6 distinguishes from claim 1 only in that it recites mapping the set of coordinates to a data. Ericson discloses this at col. 6 lines 26-39 and line 66 to col. 7 line 20.

Claim 7 is the same as claim 3 where the time was included in the vector coordinates.

With regard to **claim 8** both Wolff and Ericson discloses the clock and the boxes associated AM and PM (Wolff - col. 3 lines 54-55).

Claim 16 is rejected the same as claim 6 except claim 16 is a system claim. Thus, arguments similar to that presented above for claim 6 is equally applicable to claim 16. Note, Wolff discloses a memory and a processor along with a display as seen in Figure 5 and its respective portions in the specification.

Claim 17 is the same as claim 3 where the where and when was included in the vector (i.e., x,y,t).

Allowable Subject Matter

5. Claims 9-15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shefali D. Patel whose telephone number is 571-272-7396. The examiner can normally be reached on M-F 8:00am - 5:00pm (First Friday Off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jingge Wu can be reached on (571) 272-7429. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Shefali D Patel
Examiner
Art Unit 2624

sdp

JINGGE WU
PRIMARY EXAMINER

